IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEBRASKA

BOARD OF REGENTS OF THE UNIVERSITY OF NEBRASKA and UNEMED CORPORATION,	)	Case No. 09-cv-3075-RGK-CRZ
Plaintiffs,	)	
v.	)	
SIEMENS HEALTHCARE DIAGNOSTICS INC.,	)	
Defendant.	)	

PLAINTIFFS' BRIEF IN OPPOSITION TO SIEMENS HEALTHCARE DIAGNOSTICS INC.'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT OF U.S. PATENT NO. 5,985,670

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Plaintiffs, the Board of Regents of the University of Nebraska ("University") and UNeMed Corporation ("UNeMed") (hereinafter referred to collectively as the "University"), submit this Brief in Opposition to the Motion for Partial Summary Judgment filed by Defendant Siemens Healthcare Diagnostics Inc. ("Siemens").

I. INTRODUCTION

Siemens has filed a Motion for Partial Summary Judgment addressed to one of the two patents at issue in this case, U.S. Patent No. 5,985,670 ("the '670 patent"). As further explained below, Siemens infringes the '670 patent both literally and under the doctrine of equivalents. At a minimum, the University's cause of action for infringement of the '670 patent presents genuine issues of material fact. Based on the evidence adduced thus far, including evidence offered by Siemens itself, the University intends and expects to prevail on that cause of action at trial. Siemens' Motion for Partial Summary judgment should therefore be denied.

Siemens' motion raises two principal issues related to the '670 patent. The first is an issue of claim construction, the second relates to infringement – both literal infringement and infringement under the doctrine of equivalents. On the first issue, based largely on the specification and prosecution history of the '670 patent, the University asserts that the phrase "the same machine readable code as said first container" refers to "a machine readable code that is correlated with the machine readable code of the first container." For its part, Siemens ignores the patent specification and prosecution history in its assertion that "same" must be narrowly interpreted to mean precisely identical.

The parties previously submitted their Joint Claim Construction and Prehearing Statement (Filing No. 64) pursuant to the Court's Final Progression Order (Filing No. 33), and that statement already addresses the claim construction issue raised by Siemens' motion. (Filing No. 64 at 5.) In filing that statement, the University and Siemens both identified and attached the evidence they intend to offer in support of their respective positions at the Markman hearing, which is currently scheduled for August 26 and 27, 2010. (See Filing No. 64-1 at 13-14; Filing No. 64-2 at 52-53.)

Because the Court cannot rule on Siemens' Motion for Partial Summary Judgment without addressing the claim construction issues that have already been submitted and scheduled for hearing, the University respectfully suggests that any ruling on the Motion for Partial Summary Judgment should be deferred until after the Markman hearing. Regardless of when the Court rules, however, Siemens' motion should be denied.

The cornerstone of Siemens' argument on claim construction – that "same" means identical in every respect – has some cosmetic appeal, but it ignores the fact that "same" is broader than "identical" and fails to comply with the rules of claim construction laid down by the Supreme Court and the Federal Circuit. Those rules require that the claims of a patent must be construed in light of the patent specification, which provides "the single best guide to the meaning of a disputed term," and the prosecution history, if it is in evidence. Phillips v. AWH Corp., 415 F.3d 1303, 1315-17 (Fed. Cir. 2005) (quoting Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996)); Markman v. Westview Instruments, Inc., 517 U.S. 370, 389 (1996). Siemens' claim construction argument ignores the specification of the ’670 patent, which makes clear that the phrase “same machine readable code as said first container” refers to a machine readable code of the carrier that is correlated with the machine readable code of the first container.

The University respectfully submits that, as further discussed below, the machine readable code on the carrier and the specimen container need only be “correlated,” and need not be identical. Siemens admits that if this is so, then its StreamLAB Analytical Workcell (“StreamLAB”) infringes this claim element of the ’670 patent, and there will be no reason to consider the doctrine of equivalents. Even if Siemens were to be deemed correct on its claim construction argument, issues of fact would still remain as to whether StreamLAB infringes the ’670 patent literally and under the doctrine of equivalents. See Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 608 (1950) (an invention which does not literally infringe any claim of a patent, but which “performs substantially the same function in substantially the same way to obtain the same result,” nonetheless infringes that patent).

As the claims and specification of the ’670 patent make clear, the key features of the codes that mark the carrier and specimen container are that they must be “machine readable” and must be correlated. Marking the carrier and specimen container with machine readable codes allows the computerized laboratory automation system to track and direct the carrier and container as they move throughout the system. Siemens concedes that its use of an RFID tag to mark the carrier and a bar code to mark the specimen container performs “substantially the same function” and obtains “the same result” as the invention claimed in the '670 patent. (Filing No. 68 at 27-30.) For its doctrine of equivalents defense, Siemens argues only that StreamLAB "does not operate in substantially the same way" as the invention claimed in the '670 patent. (Id. at 28.)

At a minimum, there exist issues of fact as to whether StreamLAB operates in substantially the same way as the claimed invention. Siemens concedes that an RFID tag and a bar code are both "machine readable codes." (See Filing No. 68 at 13 ("RFID numbers and barcodes are different types of 'machine readable codes.'").) And StreamLAB tracks specimens by "associating" – i.e., by correlating – the bar code on a specimen container with the RFID tag on a carrier and uses RF sensors to monitor the location of the carrier/container combination. (Filing No. 69-8; Declaration of Kerry Miller ("Miller Decl."), ¶ 9.) This is true even if the identification codes claimed in the '670 patent were absolutely identical (which is not required according to the specification) because the laboratory automation system's computer cannot track a specimen unless those two codes are correlated. Regardless of how the Court resolves the claim construction issues presented by this motion, StreamLAB operates in substantially the same way as the invention described and claimed in the '670 patent, by correlating the identification codes of the specimen carrier and container. Any asserted differences in the manner in which bar codes and RFID tags operate are insubstantial.

II. RESPONSE TO SIEMENS' STATEMENT OF UNDISPUTED FACTS

1. *According to the Complaint, the Plaintiff Board of Regents of the University of Nebraska ("University") is a public body corporate organized and existing under the Constitution and laws of Nebraska with a principal place of business in Lincoln, Nebraska. Plaintiff UNeMed Corporation is a corporation organized under the laws of Nebraska with a principal place of business in Omaha, Nebraska. UNeMed is an affiliate of the University.*

Undisputed.

2. *Siemens Healthcare Diagnostics, Inc. is a California corporation with its principal place of business in Deerfield, Illinois.*

Undisputed.

3. *This is a patent infringement case arising under Title 35 of the United States Code Section 1, et al; and the parties agree that jurisdiction is appropriate under Title 28 of the United States Code Sections 1331 and 1338(a). The parties also agree that venue is appropriate in this judicial district under Title 28 of the United States Code Sections 1391 and 1400 and that Siemens is subject to personal jurisdiction in this district.*

Undisputed.

4. *Each claim of the '670 patent requires the step of marking the "first carrier for transporting the first container with the same machine readable code as said first container."*

Undisputed that the quoted language accurately recites part of the claim element at issue.

5. *In the accused StreamLAB system, each test tube is marked with a barcode label that is unique at a given point in time and generated specifically for the specimen contained in the test tube.*

Undisputed for purposes of the present motion.

6. *In the accused StreamLAB system, the puck is embedded with a radio frequency identification (RFID) chip that transmits an identification number that is different than the barcode on any test tube that the puck is holding.*

For purposes of the present motion, the University does not dispute that the RFID identification number on the StreamLAB carrier (or "puck") is physically different than the bar code identification number. The University does dispute that these numbers are effectively different. The two numbers are associated in a lookup table by a computer in the StreamLAB system. The codes are thus merged and become the same code from the point of view of the system. (Declaration of Dr. Rodney S. Markin, M.D., Ph.D ("Markin Decl.") – Univ. S.J. Ex. 5, ¶¶ 15-16; Miller Decl. – Filing No. 69-8, ¶ 9.)

7. *Plaintiffs assert the StreamLAB system's "equivalent" of marking the first carrier with the "same machine readable code as said first container" is "associat[ing] the RFID tag on a carrier (puck) with the barcode placed on the specimen container [test tube] . . . ." In response to the patent Examiner's Rejection over prior art during prosecution of the '670 patent, the patent applicant added new claims to its patent application that for the first time required the carrier to be marked with the "same machine readable code as said first container." The original claims merely required "marking each of the specimen container and carrier with an identification code," which encompassed the alleged equivalent of using different, but associated, codes. However, the "same machine readable code" claim limitation is narrower and does not allow for different codes. The applicant was aware (and in fact Plaintiffs claim they have described in the body of the patent application) that different codes could be used and then correlated or associated with each other. However, in the end, the applicant claimed a narrower invention to secure its patent—i.e., the applicant added the "same … code" language to the claims.*

Disputed. Specifically, the University asserts that infringement is both literal infringement and infringement under the doctrine of equivalents. As explained below, the University further disputes that the specific language in question – "same machine readable code as said first container" – was the subject of a narrowing amendment made either during the prosecution of the '670 patent or during the prosecution of the '670 patent's parent application. (Univ. S.J. Ex. 3, UNMC/UNEMED002783, UNMC/UNEMED002846.) The University further disputes that the language was added in response to a rejection by the Patent Examiner; in fact, the language in question was never used to distinguish over prior art as claimed by Siemens. The University further disputes that the language constituted a narrowing amendment; in fact, it was included to describe the "directing and tracking" feature in claim 10 as originally presented. (U.S. Patent App. No. 07/997,281 ("Parent Application") – Univ. S.J. Ex. 2, SHD001447-48, SHD001453-54, SHD001459, SHD001462-63.) The University further disputes that the claim term "same machine readable code" is narrower than "marking each of the specimen container and carrier with an identification code" or that "the same machine readable code" does not allow for different codes on the carrier and container. The University specifically argued during prosecution that the claims were directed to an embodiment where the "carrier 26 is given an identification code which correlates with the specimen container" and the Patent Examiner confirmed that the University "is correct." (Id., SHD001479-80, SHD001490.) Thus, a person of ordinary skill reading the claims, specification and prosecution history would understand that the code on the carrier and the code on the container are correlated, whether the codes themselves are identical or different.

8. *The specification of the '670 patent states: "At the specimen receiving station, the carrier is given an identification code which correlates with the specimen container, so that the container and carriage may be directed throughout the laboratory automation system . . . ." Thus, a person of ordinary skill in the art reading the patent specification would understand that the first carrier could be given a code that is correlated with the specimen container.*

Undisputed.

9. *Instead of reciting the step of marking the first carrier with a code that is "correlated" with the first container, as disclosed in the patent specification, claim 1 recites marking the first carrier "with the same machine readable code as said first container."*

Disputed. First, the quoted language does not accurately recite the claim limitation. The entire claim limitation reads "marking a first carrier for transporting the first container with the same machine readable code as said first container." ('670 Patent – Univ. S.J. Ex. 1 at 5:45-47.) Second, as explained below, the phrase "same machine readable code as said first container," as applied to the carrier, is properly construed to mean a machine readable code that is correlated with the machine readable code on the first container.

10. *By using different but allegedly "associated" or correlated codes on the test tube and puck, StreamLAB operates in a way that is not substantially the same*

as using the "same code" claimed in the '670 patent because it exploits the differences between two codes, and types of codes, to properly route test tubes and pucks in the automated system.

The University does not dispute that StreamLAB uses associated (i.e., correlated) codes on the test tube and puck, and thus the University contends this constitutes at least literal infringement of the '670 patent claims. Under a doctrine of equivalents analysis, the University disputes Siemens' assertions that StreamLAB does not operate in a way that is substantially the same as using the "same code" claimed in the '670 patent and that StreamLAB's use of different codes and types of codes renders it substantially different from the '670 patent claims. Claim 1 of the '670 patent identifies the pertinent characteristic relating to the way in which the codes are marked on both the carrier and the container, namely, that the marked codes are "machine readable." Because the codes are machine readable, patient specimens can be automatically tracked and directed by computer through the laboratory system, without the risks of human error inherent in how lab technicians move and track specimens. For the purpose of this claim element, StreamLAB works in substantially the same way as the '670 patent. (Markin Decl. – Univ. S.J. Ex. 5, ¶¶ 10-15.)

11. *Using a different RFID code on the puck and then attempting to associate that code with different code on the test tube, such as a barcode, is also a substantially different way of operating because it eliminates the need, under the claimed method, for a technician (or machine) to handle, manage, code and/or re-code a puck each time the puck carries a new test tube and specimen.*

Disputed. The advantages of using machine readable codes on the carrier and the container are explained in the '670 patent:

> Preferably, a computer is incorporated with the laboratory work stations, and includes a sensor located at each work station and archiving station. Each carrier and specimen container is marked with an identification code which is read by the sensor and transmitted to the computer. The computer

> may then operate a carrier removal apparatus at a predetermined work station to remove the carrier at the appropriate location for testing.
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> * * *
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> Referring now to FIG. 2, a schematic diagram of specimen movement throughout the laboratory automation system is shown. The specimen arrives at a specimen receiving station 22, where the specimen is entered on a conveyor system designated generally at 24. During the assignment of the task of obtaining a specimen, the laboratory information system would also provide a specimen container marked with an appropriate patient identification code. The inventor has found that a conventional bar code label applied to the specimen container is a simple and efficient method for fulfilling this function. Since most specimen containers are not designed for transport on a conveyor system, a separate carrier 26 is provided to support an individual specimen container on conveyor system 24. At specimen receiving station 22, the carrier 26 is given an identification code which correlates with the specimen container, so that the container and carriage may be directed throughout the laboratory automation system, even when the specimen container is removed from the carriage for specific testing at a work station.
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> * * *
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> Referring now to FIG. 3, an enlarged view of a portion of the schematic of FIG. 2 is shown. Specimen processing station 28 and work station 30 are shown in schematic view to demonstrate each specific work station located along conveyor system 24. As carrier 26 moves along conveyor 24, it will pass within the zone of specimen processing station 28 where a sensor 38 will detect the identification code on carrier 26. In the preferred embodiment of the invention, sensor 38 is a bar code reader while the identification code on the carrier 26 is a bar code. Sensor 38 is connected with the LIS, to record the movement of carrier 26.

('670 Patent – Univ. S.J. Ex. 1 at 2:30-4:23.)

As described in the '670 patent, the carrier and container codes provide a way to (a) include patient identification and desired test information on a particular specimen container, (b) provide a unique identifier on a particular carrier which can be easily correlated with the code on the specimen container, and thereby (c) allow system sensors and computers to direct and track the carrier and, thus, the specimen container, throughout the laboratory system so that tests can be performed on the specimen. (Id.)

The only important aspect of the way in which the carrier codes are marked is so that "sensor 38" can detect the codes, i.e., the codes need to be machine readable to facilitate directing and tracking of the specimens by the automated, computerized system. (Markin Decl.–Univ. S.J. Ex. 5, ¶¶ 12-13.) The precise technology used, whether RFID tags, bar codes, color codes, or other coding technology, is insignificant as long as the codes used on the carriers are "machine readable," and thus can be correlated by the laboratory automation system with the patient identification codes on the respective specimen containers. (Id., ¶ 14.) Further, once the code on the specimen container and code on the carrier are associated in StreamLAB, the two codes are the "same" for the purposes of directing and tracking the specimen container. (Id., ¶¶ 15-16.)

12. *Unlike the claimed method in which a single container must be transported by a single carrier that shares its same code throughout the process, test tubes in the StreamLAB system can be placed in different pucks, with different RFID numbers, during the process. This can occur because receiving an RFID number in a puck, unlike reading the "same code" applied to the carrier in the claimed method, does not directly access the identity of the specimen. Because the code on the puck is independent from the code on the test tube, the puck can be integrated into the conveyor and re-used without changing its RFID number regardless of the number of test tubes carried. This increases efficiency, maximizes throughput, conserves resources and reduces the possibility of human or machine error (in handling and re-coding the pucks). The interchangeability of pucks and test tubes – permitted by the use of different codes (and precluded by the use of the "same . . . code") – is fundamentally different from the mono-code approach of the '670 patent, which requires a container and carrier to remain together (or if separated, to re-unite) during the process.*

Disputed. The claimed method does not require a single container to be transported by a single carrier that shares an identical code with the container throughout the process. ('670 patent–Univ. S.J. Ex. 1 at 5:39-6:19.) Nor does the claimed method require directly accessing the identity of the specimen. As pointed out above, "a sensor 38 will detect the identification code on carrier 26" to facilitate recordation of the movement of the carrier 26. (Id., 4:16-19). Disputed that the code on the puck is independent from the code on the test tube – they are associated in a look-up table. (Miller Decl. – Filing No. 69-8, ¶ 9.) Disputed that the '670 patent requires a "mono-code" approach. ('670 patent – Univ. S.J. Ex. 1, 3:47-53, 5:45-47.) Disputed that the '670 patent requires a container and carrier to remain together or reunite. ('670 patent–Univ. S.J. Ex. 1 at 3:50-53) ("specimen container is removed from the carriage for specific testing at a work station"). The purported "fundamental differences" between StreamLAB and the '670 patent which are described by Mr. Miller are design choices which would occur to a person with ordinary skill in the art. (Markin Decl. – Univ. S.J. Ex. 5, ¶¶ 17-26.)

III. SUMMARY JUDGMENT STANDARD

"Summary judgment should be granted only 'if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.'" Trimble v. BNSF Ry. Co., 636 F. Supp. 2d 916, 919 (D. Neb. 2009) (quoting Fed. R. Civ. P. 56(c)). In deciding a motion for summary judgment, the district court must view the facts in the light most favorable to the party opposing the motion. Trimble, 636 F. Supp. 2d at 919 (citing Dancy v. Hyster Co., 127 F.3d 649, 652 (8th Cir.1997)). "It is not the court's function to weigh evidence in the summary judgment record to determine the truth of any factual issue." Id. (citing Bell v. Conopco, Inc., 186 F.3d 1099, 1101 (8th Cir.1999)).

IV. ARGUMENT

Siemens' Motion for Partial Summary Judgment is premature and should be denied. As set forth above, the University respectfully suggests that any ruling on this motion should wait until after the Markman hearing currently scheduled for August 26 and 27. When the Court does rule on Siemens' Motion for Partial Summary Judgment, it should deny the Motion for three separate reasons. First, the portion of Siemens' motion directed to claim construction ignores the specification of the '670 patent and critical portions of the prosecution history, which unequivocally explain that the term "same machine readable code as said first container" means a machine readable code that is "correlated" with the machine readable code of the first container. Second, even if "same" were to be construed to mean "identical," there would be an issue of fact as to whether the linked and correlated codes of the carrier and specimen container in StreamLAB are the "same" to the laboratory automation system. Third, the portion of Siemens' motion directed to the doctrine of equivalents is the subject of numerous issues of fact that, when viewed in the light most favorable to the University, prevent the entry of summary judgment.

A. The '670 patent's reference to the claim language, "the same machine readable code as the first container," means a machine readable code of the carrier that is correlated to the machine readable code of the first container.

Siemens' arguments on claim construction present an issue of law, Cohesive Techs., Inc. v. Waters Corp., 543 F.3d 1351, 1360 (Fed. Cir. 2008), which in this case must be resolved in favor of the University. As explained below, well established case law requires that the claims of a patent must be read in light of its specification, just as the words of a contract must be interpreted in light of each other. When the claims and specification of the '670 patent are read together, and in light of the prosecution history, it is clear that "same" in the claim term at issue refers to "correlated" machine readable codes marking the specimen container and carrier. Siemens' Motion for Partial Summary Judgment should therefore be denied on this ground alone.

1. The claims of a patent must be construed in light of the specification.

For purposes of the claim construction issue raised by Siemens' motion, a patent contains two key components – its specification and its claims.[1] The patent specification must contain a "written description" of the invention. 35 U.S.C. § 112. At the conclusion of the specification, the patent must also list "one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Id.

The metes and bounds of a patent are judged by its claims, the words of which "are generally given their ordinary and customary meaning." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). But in construing the claims, courts may not ignore the specification. As the Supreme Court has held, the specification is a "component part of the patent," "as much to be considered with the [claims] in construing them, as any paper referred to in a deed or other contract." Hogg v. Emerson, 47 U.S. (6 How.) 437, 482 (1848). Accordingly, "it is fundamental that claims are to be construed in light of the

[1] The original claims of a patent are technically part of the specification. 35 U.S.C. § 112. However, the term "specification" is typically used to refer to the patent's written description, as opposed to the claims. See, e.g., Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005).

specifications and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49 (1966).

The Federal Circuit explained the relationship between a patent's claims and its specification in Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005). In Phillips, the court noted that "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." Phillips, 415 F.3d at 1313. "Importantly," held the court, "the person of ordinary skill in the art is deemed to have read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." Id. (emphasis added) (citing Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477 (Fed. Cir. 1998)). Thus, "[t]he construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." Id. at 1316 (citing Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1250 (Fed. Cir. 1998)). In addition to the specification, "the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention." Id. at 1317.

2. The plain and ordinary meaning of "same" does not require exact identity.

Throughout its brief, Siemens implicitly uses the term "same" to mean identical. The plain and ordinary meaning of the word "same," however, as used in the '670 patent, does not require that the machine readable codes of the specimen container and carrier be identical. It is true that one dictionary definition of the word "same" refers to "someone or something identical with another." See The

American Heritage Dictionary (Second College Ed. 1982). But dictionaries also give another definition to "same," as meaning "similar in kind, quantity, or degree." Id.; see also Webster's Third New Int'l Dictionary of the English Language Unabridged (2002) (hereinafter, "Webster's Third") (defining "same" as "something identical with or similar to another") (emphasis added).[2]

Machine readable codes that are "correlated" fall within this latter meaning. The word "similar" means "alike in substance or essentials: CORRESPONDING." Webster's Third. It also means "one that resembles another: COUNTERPART." Id. The machine readable codes that mark the specimen container and carrier in the '670 patent do "correspond" to one another. They are "counterparts" of each other, alike in one respect that is critical to the way the '670 patent works, i.e., through the computer's correlation of the two codes, a particular specimen is tracked and directed as it moves throughout the laboratory automation system.

3. The term "correlated" in the patent specification imparts meaning to the term "same" in the claims.

The specification of the '670 patent confirms that its claims use the word "same" to refer to machine readable codes that are correlated with one another. The specification does not refer to identical codes when describing the codes that are marked on the specimen container and carrier. Instead, it describes the correlation of these two codes:

> At specimen receiving station **22**, the carrier **26** is given an identification code which correlates with the specimen container, so that the container and the carriage may be directed throughout the

[2] The Supreme Court itself has recognized that "same" does not require exact identity. Addressing the doctrine of equivalents, the Court has held that "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape." Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 608 (1950) (emphasis added).

> laboratory automation system, even when the specimen container is removed from the carriage for specific testing at a work station.

(Univ. S.J. Ex. 1 at 3:47-53.) Thus, as the specification explains, the machine readable codes marking the container and carrier are similar in that they are correlated with each other so that the specimen container can be automatically tracked as it moves throughout the laboratory automation system. (Id.) The specification never suggests that the container and carrier codes are required to be identical or even that identical codes would be desirable. (Id.)

4. The prosecution history supports the construction that "same" means "correlated."

Two important aspects of the prosecution history confirm that the '670 patent claims codes that are correlated, but need not be identical. First, in describing its invention to the Patent Office, the University stated – and the Patent Examiner agreed – that the identification codes marking the carrier and container were to be correlated; it never said they were identical. Second, the Patent Examiner implicitly found the "same machine readable code" element was taught by prior art that did not describe "identical" codes. The University did not attempt to distinguish that prior art on the grounds that the '670 patent requires machine readable codes that are identical, as it surely would have had it intended such a narrow meaning. Thus, the prosecution history confirms that neither the Patent Examiner nor the University interpreted the term "same machine readable code" to require identical codes.

a. The University expressly described its invention as using correlated codes.

The prosecution history confirms the fact that the University and the Patent Examiner both understood the '670 patent to claim correlated machine readable codes. During the prosecution of the '670 patent's parent application, the University appealed the Patent Examiner's rejection of claims 10 and 11, both of which included the "same machine readable code" language here at issue. (Univ. S.J. Ex. 2 at SHD001487-88.) During that appeal, the University filed a brief which, as required by the rules of practice before the Patent Office, described the claimed invention. That brief explained, in pertinent part, as follows:

> At specimen receiving station 22, the carrier 26 is given an identification code which correlates with the specimen container, so that the container and carriage may be directed throughout the laboratory automation system even when the specimen container is removed from the carriage for specific testing at a work station.

(Id., SHD001479-80) (emphasis added). In the Patent Exaiminer's Answer, he agreed with the University, stating, "The summary of the invention contained in the brief is correct." (Id., SHD001490.) This definitional statement is unequivocal and makes clear to the public the scope of the claims.

b. Neither the Patent Examiner nor the University viewed "same" as identical.

Contrary to Siemens' argument, the "same machine readable code" element was not added during prosecution of the parent application to distinguish over the prior art. The language at issue was introduced when claim 10 was added in the parent application to claim "directing and tracking" of the specimen container and carrier. But the University never argued that "same machine readable code" distinguished over the prior art.

If the University had believed the '670 patent claimed identical codes, it would have used that to distinguish its patent application from that prior art. After claim 10 was added, the Patent Examiner rejected it, implicitly finding that the Uchida Patent taught the claim element "same machine readable code." (Id., SHD001459, SHD001462-63.) Importantly, the Uchida Patent does not teach "identical" codes. Rather, the Uchida Patent teaches the use of different kinds of "codes" for entirely different purposes – a bar code to identify specimen containers for testing and a cut plate or magnet on a sample rack to identify the test priority (i.e., ordinary, emergency, or control) to be given to specimens loaded on that rack. (Id., SHD001405-6, SHD001407, SHD001411.) If the University had intended "same" to mean "identical" in this context, it could and would have distinguished the Uchida Patent by saying so. The University did not, and it never attempted to distinguish the claims of the '670 patent over the Uchida Patent on the basis that the Uchida Patent did not teach identical codes. Thus, the prosecution history demonstrates that neither the University nor the Patent Examiner viewed "same" codes as identical codes.

B. StreamLAB literally infringes the '670 patent.

Regardless of how the Court decides the claim construction issue before it, summary judgment will be inappropriate. Whether an accused product literally infringes a patent is a question of fact for a jury. Lucent Techs., Inc. v. Gateway, Inc., 580 F.3d 1301, 1309 (Fed. Cir. 2009); Cohesive Techs., 543 F.3d at 1371. In this case, there are at least issues of fact as to whether Siemens is liable for literal infringement of the '670 patent.

Siemens concedes that the codes marked by its RFID tag and bar code are correlated through a computer database. Specifically, Siemens states that the StreamLAB computer "associates the two different codes in a look-up table." (Filing No. 68 at 8; Miller Decl. – Filing No. 69-8, ¶ 9.) Thus, if the Court agrees with the University and finds that the phrase "the same machine readable codes as said first container" means "a machine readable code that is correlated with the machine readable code of the first container," Siemens has acknowledged that it literally infringes this claim term of the '670 patent.

Even if the Court were to find that the carrier and container must be provided with an identical code, the lookup table in the computer database appears to do just that – it merges the codes provided on the carrier and container into a single, correlated ("associated") code in the computer database. (Univ. S.J. Ex. 5 – Markin Decl., ¶ 15.) Because Siemens' database appears to merge the two codes into a single code, there is at least a question of fact under Siemens' own construction as to whether StreamLAB uses an identical code under its own proposed construction of the '670 patent.

C. Even if literal infringement were not found, StreamLAB infringes the '670 patent under the doctrine of equivalents.

The doctrine of equivalents recognizes that "[o]ne who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy." Graver Tank, 339 U.S. at 607. "Under the doctrine of equivalents, 'a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention.'" Voda v. Cordis Corp., 536 F.3d 1311, 1324 (Fed. Cir. 2008).

As the evidence submitted by both Siemens and the University demonstrates, there is no substantial difference in the way StreamLAB and the '670 patent use machine readable codes marked on a carrier and specimen container. Both Siemens' StreamLAB and the claims of the University's '670 patent mark the specimen container and the carrier with a machine readable code and then correlate the machine readable codes to track and direct specimens as they move through a laboratory automation system. Any design differences between using RFID tags and bar codes or other machine readable codes are insubstantial when compared with the central importance of correlating the machine readable codes marking the carrier and the specimen container "so that the container and carrier may be directed throughout the laboratory automation system" as the '670 patent teaches. Perhaps recognizing the substantial similarity between its product and the claims of the '670 patent, Siemens seeks refuge in a number of possible limitations to the doctrine of equivalents – prosecution history estoppel, the "disclosure-dedication" rule, and the "all elements" rule. Consideration of the '670 patent and its prosecution history, however, reveals that none of the limitations urged by Siemens apply in this case.

1. The way the '670 patent and StreamLAB implement machine readable codes are substantially the same.

The Federal Circuit has discussed three tests to judge whether a patent and an accused product are equivalents. The first test is the "function-way-result" test. Interactive Pictures Corp. v. Infinite Pictures, Inc., 274 F.3d 1371 (Fed. Cir. 2002). Under this test, an element in the accused device is equivalent to the claim element if it "performs substantially the same function in substantially the same way to obtain the same result." Overhead Door Corp. v. Chamberlain Group, Inc. 194 F.3d 1261, 1270 (Fed. Cir. 1999). The second test is the "insubstantial differences" test. Voda, 536 F.3d at 1326. "Under the insubstantial differences test, 'an element is equivalent to a claim limitation if the only differences between the two are insubstantial.'" Id. The third test is the "interchangeability test." IMS

Technology, Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1435 (Fed. Cir. 2000). The "interchangeability test looks to the knowledge of a skilled artisan to see whether that artisan would contemplate the interchange as a design choice." Interactive Pictures, 274 F.3d at 1383.

Regardless of which test is applied, whether an accused product infringes a patent is almost always a question for the finder of fact. As the Federal Circuit has held, summary judgment under the doctrine of equivalents is not appropriate unless the accused infringer meets the "lofty standard" of showing "no reasonable fact-finder could find equivalence." Overhead Door Corp., 194 F.3d at 1269. In this case, there are at least issues of fact as to whether StreamLAB is equivalent to the claims of the '670 patent in its use of associated machine readable codes to direct and track a specimen container and carrier throughout the laboratory automation system.

a. StreamLAB infringes under the function-way-result test.

Siemens does not contest that, as to the disputed claim element, StreamLAB performs the same function as the claims of the '670 patent and achieves the same result. Instead, citing the Declaration of Kerry Miller, Siemens argues that StreamLAB accomplishes its function and result in a substantially different way than the invention claimed in the '670 patent. Miller's declaration, however, actually demonstrates that Siemens' product and the '670 patent operate in substantially the same way.

"[T]he function-way-result inquiry focuses on 'an examination of the claim and the explanation of it found in the written description of the patent.'" AquaTex Indus., Inc. v. Techniche Solutions, 479 F.3d 1320, 1326 (Fed. Cir. 2007). As the

’670 patent explains, the purpose of marking the carrier and container with machine readable codes is to readily correlate them “so that the container and carriage may be directed throughout the laboratory automation system even when the specimen container is removed from the carriage . . . .” (See, e.g., ’670 patent – Univ. S.J. Ex. 1 at 3:47-53.) With the two codes thus correlated, the laboratory automation system can keep track of the specimen container and carrier. (Id., at 6:4-9.)

The key to this operation lies in using codes that are correlated (or, as Siemens puts it, associated), not in using codes that are identical. Using codes that are correlated (whether or not identical) allows the system to operate as described in the ’670 patent, i.e., to keep track of the specimen and the carrier. On the flip side, even if the codes marking the carrier and the container are identical, if they are not also correlated, a computer could not keep track of the specimen if it were removed from the carrier. (Markin Decl. – Univ. S.J. Ex. 5, ¶¶ 13-14.)

Siemens’ own evidence demonstrates that StreamLAB operates in a way that is substantially similar to the ’670 patent. Siemens admits that the RFID tag and bar code used by StreamLAB are both “machine readable codes.” (See, e.g., Miller Decl. – Filing No. 69-8, ¶ 8.) Siemens further concedes that StreamLAB tracks a specimen container throughout the system by tracking its carrier – not the container itself. (Id. at ¶¶ 6 & 9.) Finally, Siemens acknowledges that StreamLAB operates in this way by associating, in a computer database, the codes used to mark the carrier and container. (Id. ¶ 9.) Put simply, StreamLAB uses correlated, machine readable codes to operate in substantially the same way as the invention claimed in the '670 patent, i.e., it keeps track of the location of carrier and the specimen container that is correlated with that carrier.

b. StreamLAB infringes under the insubstantial differences test.

Siemens also argues that there are substantial differences between StreamLAB as it exists (e.g., a combination of an RFID code on the carrier and bar code on the container) and a hypothetical StreamLAB posited as using either (a) an RFID code on both the container and carrier or (b) a bar code on both the container and carrier. Whatever superficial appeal Siemens' approach may have, it is legally incorrect. The law requires that the comparison be made between the accused system (i.e., StreamLAB as it actually exists) and the invention claimed in the patent. AquaTex, 479 F.3d at 1328 ("[i]nfringement is not determined … by comparison between commercial products sold by the parties"). The patent claim does not require the use of either RFID tags or bar codes on the carrier and container as Siemens contends, only the use of codes that are "machine readable."

It is also legally insufficient that Siemens identifies some differences between RFID and bar code technology in its effort to avoid infringement under the doctrine of equivalents. Any equivalents analysis presumes that some differences exist between the accused product and the claim language. Ethicon Eno-Surgery, Inc. v. U.S. Surgical Corp., 149 F.3d 1309, 1316-17 (Fed. Cir. 1998). To be "significant," such differences must be important to the claimed invention. IMS Tech., 206 F.3d at 1436-37. In IMS Technology, for example, the court found that physical differences between a floppy disk drive and a tape transport were insignificant, noting that it did not appear that "any physical characteristics of the interface means, such as the specific format of recorded data and the mechanical mechanism for accessing data, [were] important to the invention." Id. The alleged advantages of RFID technology – purportedly in cost and reliability – are not important to the way the claimed invention works. (Markin Decl. – Univ S.J. Ex. 5, ¶¶ 20-25.)

The Federal Circuit has repeatedly rejected contentions that differences in the physical characteristics of two alternatives render them substantially different. See, e.g., Overhead Door, 194 F.3d at 1269-70 (finding substantial evidence of equivalence between hardware and software implementations of a memory selection system); IMS Tech., 206 F.3d at 1436-37. Here, StreamLAB has the characteristics that are pertinent to the claim – the codes are both machine readable and correlated. (Miller Decl. – Filing No. 69-8, ¶¶ 6, 8, 9; Markin Decl. – Univ. S.J. Ex. 5, ¶¶ 13-14.) The differences discussed by Mr. Miller in his declaration are insubstantial to the claims.

c. StreamLAB infringes under the interchangeability test.

The interchangeability test provides further confirmation that StreamLAB's use of machine readable codes to mark the carrier and specimen container is equivalent to the '670 patent. The "interchangeability test looks to the knowledge of a skilled artisan to see whether that artisan would contemplate the interchange as a design choice." Interactive Pictures, 274 F.3d at 1383. In this case, Siemens' own witness – Mr. Miller – states that a skilled artisan would contemplate the interchange of bar codes and RFID tags in technology used to track specimens in a laboratory automation system.

To begin with, the declaration of Mr. Miller offers various design features which purportedly make RFID technology more attractive "machine readable codes" than bar codes for purposes of tracking a carrier in a laboratory automation system. (See Miller Decl. – Filing No. 69-8, ¶¶ 10-16.) As noted above, the choice of one or the other is not essential (or even substantially related) to the invention described and claimed in the '670 patent. Instead, they are design choices that would occur to someone with ordinary skill in the art. (Markin Decl. – Univ. S.J. Ex. 5, ¶¶ 17-26.)

Not only would a hypothetical skilled artisan contemplate the interchange of bar codes or RFID tags as a design choice, Mr. Miller himself has done just that. The specification of U.S. Patent No. 7,681,466, of which Mr. Miller is an inventor, describes the use of bar codes and RFID tags as equivalent means for use on a carrier and thus for locating a sample tube (i.e., a specimen container) in a "sample handling system":

> Sample handling system 10 has a number of sensors 38 for detecting the location of a sample tube 12 by means of identifying indicia placed on or within each sample tube carrier 18. Conventional bar-code readers or radio-frequency locating devices may be employed in such tracking operations.

U.S. Patent No. 7,681,466 – Univ. S.J. Ex. 4, 4:37-43. Thus, as reflected in Mr. Miller's own statement to the public via his patent,[3] bar code readers and RFID readers are both suitable for use in tracking a carrier used in a laboratory automation system in order to locate a specimen container, and he points out that the two codes are fungible.

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[3] Mr. Miller's statements, both in his declaration and in his patent, are relevant to whether the '670 patent and StreamLAB are equivalents. In contrast, contrary to Siemens' argument, the claims of U.S. Patent No. 5,589,137, on which Dr. Markin is an inventor, are not relevant to the issues of claim construction before the Court, because that patent bears no formal relationship to the '670 patent. Goldenberg v. Cytogen, Inc., 373 F.3d 1158, 1167-68 (Fed. Cir. 2004).

d. At a minimum, equivalents presents questions of fact.

Like literal infringement, infringement under the doctrine of equivalents is an issue of fact. See Crown Packaging Tech, Inc. v. Rexam Beverage Can Co., 559 F.3d 1308, 1315 (Fed. Cir. 2009). At a minimum, there are issues of fact as to whether Siemens' use of correlated machine readable codes is equivalent to the use of the "same machine readable code" claimed in the '670 patent. StreamLAB and the claimed invention use the codes in substantially the same way – by associating the codes on the container and its carrier in order to keep track of the container and carrier throughout the laboratory automation process. Any differences between RFID tags and bar codes or other "machine readable" codes for this purpose are insubstantial when compared to the key similarities of being machine readable and, thus, easily correlated, so the choice between RFID tags and bar codes is one which a skilled artisan could reasonably contemplate, precisely as Mr. Miller did. These issues of fact preclude Siemens' request for summary judgment under the doctrine of equivalents.

2. No limitations to the doctrine of equivalents apply.

In an attempt to avoid the doctrine of equivalents, Siemens invokes three theories which it argues limit the doctrine in this case – prosecution history estoppel, the disclosure-dedication rule, and the all elements rule. These proposed limitations all present issues of law. See DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc., 567 F.3d 1314, 1323-24 (Fed. Cir. 2009); Pfizer, Inc. v. Teva Pharm., USA, Inc., 429 F.3d 1364, 1378-79 (Fed. Cir. 2005). As a matter of law, these limitations do not apply to the claim elements at issue and thus do not preclude or limit application of the doctrine of equivalents.

a. Prosecution history estoppel is inapplicable.

Careful reading of the prosecution history of the '670 patent makes clear that prosecution history estoppel neither limits nor forecloses application of the doctrine of equivalents. Prosecution history estoppel can arise where an applicant makes a narrowing amendment to the claim for a reason related to patentability. Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 736 (2002). Although a bar to equivalents is presumed when such a narrowing amendment is made, that presumption may be rebutted by a showing that (1) "the equivalent [was] unforeseeable at the time of the patent application," (2) "the rationale underlying the amendment [bore] no more than a tangential relation to the equivalent in question;" or (3) "some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question." Id. at 740-41. As discussed below, prosecution history estoppel does not apply in this case. The University's inclusion of the "same machine readable code" language to the '670 patent claims was not a narrowing amendment, was not related to patentability, and was tangential to the equivalent at issue.

i. Inclusion of the "same machine readable code" language was not a narrowing amendment.

Siemens argues that prosecution history estoppel should apply because the claims of the '670 patent were amended during prosecution to include the phrase "same machine readable code." Specifically, Siemens contends that claim 1 of the '670 patent is a re-filed version of claim 10 of the parent application. Siemens goes on to suggest that the "same machine readable code" element was added to claim 10 of the parent as a narrowing amendment, in order to overcome a rejection from the Patent Examiner that the parent application was obvious in light of three earlier patents – JP 63-271164 (the "Okuno Patent"), JP 4-204150 (the "Wakatake Patent"), and JP 1-301167 (the "Uchida Patent"). (Filing No. 68 at 3-4.) Siemens is wrong. As outlined below, the prosecution history demonstrates that the disputed language was included in claim 10 from the beginning, and its inclusion in claim 10 had nothing to do with any prior art.

As the Supreme Court held in Festo, prosecution history estoppel does not arise unless "an amendment is made to secure the patent and the amendment narrows the patent's scope." Festo, 535 U.S. at 736 (emphasis added). As Siemens itself acknowledges, the "same machine readable code" language was included in new claim 10 of the parent application while original claim 1 was still pending. Claim 10 was not an amendment of claim 1 made "to secure the patent," nor was claim 10 amended as to that element. Portions of the prosecution history that Siemens omitted from its brief make this point clear.

As Siemens concedes, once claim 10 was added, it was not altered in any significant way. The table below shows the relevant portion of claim 10 as filed in the parent application, claim 1 as filed in the application for the '670 patent, and claim 1 as issued in the '670 patent:

Claim 10 as Filed in the Parent Application	**Claim 1 as Filed in the '670 Patent Application**	**Claim 1 as Issued in the '670 Patent**
A method of automatically testing and tracking a specimen in a laboratory, comprising the steps of: placing a first specimen to be tested into a first specimen container;	A method of automatically testing and tracking a specimen in a laboratory, comprising the steps of: placing a first specimen to be tested into a first specimen container;	A method of automatically testing and tracking a specimen in a laboratory, comprising the steps of: placing a first specimen to be tested into a first specimen container;

marking the first container with a machine readable code; marking a first carrier for transporting the first container with the same machine readable code as said first container, and placing the container thereon; ***	marking the first container with a machine readable code; marking a first carrier for transporting the first container with the same machine readable code as said first container, and placing the container thereon; ***	marking the first container with a machine readable code; marking a first carrier for transporting the first container with the same machine readable code as said first container, and placing the container thereon; ***

(Univ. S.J. Ex. 2, SHD001447-1448; Univ. S.J. Ex. 3, UNMC/UNEMED002783; Id., UNMC/UNEMED002846.) Thus, the prosecution history of the '670 patent – and even of the parent application after the addition of claim 10 – shows that the claim language relating to the marking of the code on the "first carrier" remained unchanged throughout the prosecution and was never the subject of any amendment, let alone a narrowing amendment that would be required to trigger prosecution history estoppel. Festo, 535 U.S. at 736-37.

Siemens tries to overcome this shortcoming by arguing that the addition of claim 10 in the parent application should be characterized as somehow responsive to the Patent Examiner's rejection of original claim 2, which had claimed "marking each of the specimen container and carrier with an identification code, prior to the step of placing the carrier on the conveyor." (Univ. S.J. Ex. 2, SHD001354.) The Patent Examiner rejected claim 2 on the grounds that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to label both the specimen container and the carrier . . . ." (Univ. S.J. Ex. 2, SHD001435.) What Siemens fails to state is the reason the Patent Examiner believed such marking would have been obvious:

> because labeling the carrier permits the analyzer to prioritize the order of processing a particular sample as taught by Okuno and because maintaining specific identifying labels on specimens, e.g., patient identity, sampling date, etc., is essential to accurate record keeping and maintenance of samples in the field of automated medical or chemical analysis, as would have been recognized by one of ordinary skill in the art.

(Id.) Significantly, neither of the reasons given by the Patent Examiner for the rejection of claim 2 related to tracking and directing a specimen container or locating its position as it moves throughout the laboratory automation system.

Siemens speculates that the "same machine readable code" language was subsequently included in new claim 10 to overcome the Uchida Patent. (Siemens' Br. at 20.) The prosecution history, however, demonstrates that the "same machine readable code" claim element was not included in claim 10 to overcome the Patent Examiner's rejection of claim 2.

In contrast to the Patent Examiner's reasons for rejecting claim 2, the reasons given by the University for adding claim 10 related precisely to directing and tracking a specimen container as the carrier moves throughout the laboratory automation system.[4] Claim 10 included the following elements: "marking the first container with a machine readable code"; and "marking a first carrier for transporting the first container with the same machine readable code as said first container, and placing the container thereon." (Univ. S.J. Ex. 2, SHD001447-1448.) In adding this claim, the University remarked –

> New claims 10 and 11 more specifically call for the method of directing and tracking the movement of the specimen carriers throughout the laboratory. This movement is directed in response to the particular tests to be conducted on the specimens, as well as

[4] The critical language of claim 2 – "marking each of the specimen carriers and containers with an identification code" – was not abandoned, but was moved to claim 1 of the parent application. (Univ. S.J. Ex. 2, SHD001446.)

> priorities given to the specimens or particular tests to be conducted on the specimens. None of the cited references disclose or suggest such features. It is therefore believed that new claims 10 and 11 are allowable.

(Univ. S.J. Ex. 2, SHD001453) (emphasis added). This explanation demonstrates that claim 10 was added to point out a feature of the invention, namely, "directing and tracking" of the specimen carriers in response to particular tests to be conducted or the priority given to those tests or the specimens themselves. Although "same machine readable code" is part of claim 10, nothing in the University's remarks suggest that this claim element was included or needed to distinguish over any prior art. Had the University intended to distinguish over the prior art based on the "same machine readable code" element, as opposed to more specifically claiming "directing and tracking," it would have focused the attention of the Patent Examiner on such a distinction. That did not occur.

The subsequent prosecution of claim 10 in the parent application provides conclusive evidence that the "same machine readable code" element was not added to overcome the Patent Examiner's rejection. Following the addition of claim 10, the Patent Examiner issued a new Office Action rejecting claim 10 as obvious over a combination of references, including the Okuno, Wakatake, and Uchida Patents. In making that rejection, the Patent Examiner implicitly relied upon the Uchida Patent for teaching the "same machine readable code" element, just as the Patent Examiner had previously relied on the Uchida Patent for teaching marking of the carrier and container as had been set forth in the original claim 2. (Univ. S.J. Ex. 2, SHD001435, SHD001459, SHD001462-63.) Never did the University argue that the disputed claim element distinguished over Uchida or any other prior art. (Univ. S.J. Ex. 3, UNMC/UNEMED002832-2833.) Instead, the University relied on other features of the claimed invention for patentability. Moreover, as previously discussed, the University expressly stated during subsequent appeal proceedings that claim 10 related to carrier and container codes that are "correlated," and the Patent Examiner confirmed that this statement of claim scope by the University was "correct." (Univ. S.J. Ex. 2, SHD001479, SHD001491.)

Finally, in allowing the claims of the '670 Patent, the Patent Examiner did not rely on the "same machine readable code" language as a basis for allowing those claims over any prior art. (Univ. S.J. Ex. 3, UNMC/UNEMED002835-2837.) Therefore, the prosecution history establishes that the "same machine readable code" element in claim 10 of the parent application (and by extension in claim 1 of the '670 patent under Siemens' analysis) was not a narrowing amendment made for a reason related to patentability.

Accordingly, Siemens remains subject to liability for patent infringement under the doctrine of equivalents as a matter of law.

ii. Even if the inclusion of the "same machine readable code" language was presumed to be a narrowing amendment, that language is tangential to the equivalent at issue.

As the Supreme Court explained in Festo, any presumption of prosecution history estoppel is rebutted when the "rationale underlying the amendment [bears] no more than a tangential relation to the equivalent in question." Festo, 535 U.S. at 740. Under that standard, even if prosecution history estoppel presumptively foreclosed the doctrine of equivalents, the presumption is rebutted because "the amendment cannot reasonably be viewed as surrendering [the] particular equivalent" in question, i.e., the use of a correlated machine readable code such as bar code and RFID code on the container and carrier, respectively. See Festo, 535 U.S. at 740.

The rejection underlying Siemens' prosecution history estoppel argument was not a rejection of claim 1 of the '670 patent or even of claim 10 of the parent application, which Siemens alleges is the predecessor to the '670 patent's claim 1. Rather, Siemens relies on a rejection of original claim 2 based upon the Okuno, Wakatake, and Uchida Patents. (Filing No. 68 at 20; Univ. S.J. Ex. 2, SHD001433-37.) In response to the Examiner's rejection of claim 2, the University amended claim 1 to include the subject matter of claim 2, i.e., "marking each of the specimen containers and carriers with an identification code." (Univ. S.J. Ex. 2, SHD001445-1446.) Claim 1, as amended, however, did not include a tracking feature. In the same response, the University added a new claim (claim 10) to claim the "tracking" features of the invention, including "marking a first carrier for transporting the first container with the same machine readable code as said first container, and placing the container thereon." (Univ. S.J. Ex. 2, SHD001447-1448.)

The only comments ever made by the University relating to how marking of the container and carrier distinguished over the prior art – which related to claim 1 of the parent application – were as follows:

> Rewritten claim 1 calls for the step of marking the specimen container and the specimen carrier with an identification code and then placing the specimen container in the carrier on the automatic conveyor. Unger does not teach or suggest such a method. Rather Unger[5] calls for a carrier having a two-part label. This two-part label has one portion which is severed and applied to a conveyor to correspond with the carrier having the second portion of the label. There is no

[5] The Unger reference was used by the Examiner to reject claim 3, which, like claim 2, required "marking each of the specimen container and carrier with an identification code."

> teaching or suggestion to apply a label to a specimen container carried on the carrier. . . .

(Univ. S.J. Ex. 2, SHD001450) (emphasis added). Thus, the only objectively apparent reason for the addition of limitations in original claim 1 relating to marking of the specimen container and carrier was to clarify that the invention required marking the carrier and the container, in contrast to the carrier and conveyor (as the prior art taught). As such, the prosecution history demonstrates clearly that the amendment in response to the Patent Examiner's rejection of original claim 2 was made to distinguish over what was marked, not the type or value of the identification codes, or how or whether they are related. This is entirely different from, and tangential to, the correlation of machine readable codes used to mark the specimen container and carrier in order to direct and track the container, which is precisely the issue of equivalents that would be presented if the Court were to adopt Siemens' proposed construction of "same machine readable code."

b. The disclosure-dedication limitation does not apply.

The "disclosure-dedication" limitation to the doctrine of equivalents does not apply here. As the Federal Circuit has held, "disclosure – dedication" is a narrow exception to the doctrine of equivalents:

> We thus hold that if one of ordinary skill in the art can understand the unclaimed disclosed teaching upon reading the written description, the alternative matter disclosed has been dedicated to the public. This "disclosure-dedication" rule does not mean that any generic reference in a written specification necessarily dedicates all members of that particular genus to the public. The disclosure must be of such specificity that one of ordinary skill in the art could identify the subject matter that had been disclosed and not claimed.

PSC Computer Prods., Inc. v. Foxconn Int'l, Inc., 355 F.3d 1353, 1360 (Fed. Cir. 2004) (emphasis added).

Applying this requirement of specificity, the Federal Circuit has held that "the public notice function of patents suggests that before unclaimed subject matter is deemed to have been dedicated to the public, that unclaimed subject matter must have been identified by the patentee as an alternative to a claim limitation." Pfizer, 429 F.3d at 1379 (emphasis added). Thus, in Pfizer, the Federal Circuit held that a patent's generic disclosure of "saccharides" did not dedicate an alleged unclaimed alternative to the public, where the alleged alternative was not specifically disclosed in the patent. Id. at 1380. Likewise, in PSC Computer, the Federal Circuit held that disclosure of "other resilient materials" was generic and was not dedicated when the applicant more narrowly claimed "stainless steel." PSC Computer, 355 F.3d at 1360.

The disclosure-dedication limitation does not apply in this case because the specification discloses the generic concept of "correlation" of machine readable codes on the carrier and container and not specific, alternative examples of correlated codes, such as identical or different correlated codes. Assuming for the sake of argument that Siemens' "identical" construction of "same machine readable code" is correct, that claim element would then relate to a particular species, i.e., correlated codes that are identical apparently in type and value. The alleged unclaimed subject matter, i.e., different types of correlated codes, such as RFID codes having different values than, for example, bar codes, was not identified to the public as an alternative to correlated "identical" codes, and thus could not have been disclaimed. The disclosure-dedication limitation does not protect Siemens from liability for infringement under the doctrine of equivalents.

c. The "all elements" rule does not help Siemens.

Siemens' argument that application of the doctrine of equivalents would violate the "all elements" rule also lacks merit. The "all elements" rule limits the doctrine of equivalents by preventing its application when a finding of equivalents would vitiate a claim limitation. Primos, Inc. v. Hunter's Specialties, Inc., 451 F.3d 841, 850 (Fed. Cir. 2006) "There is no set formula for determining whether a finding of equivalence would vitiate a claim limitation, and thereby violate the all limitations rule." Id. (citing Freedman Seating Co. v. Am. Seating Co., 420 F.3d 1350, 1359 (Fed Cir. 2005)). "Rather, courts must consider the totality of the circumstances of each case and determine whether the alleged equivalent can be fairly characterized as an insubstantial change from the claimed subject matter without rendering the pertinent limitation meaningless." Id. Where, as is the case here, a limitation is not effectively eliminated, the all elements rule is not violated. Id.

The element at issue in this motion, in its entirety, reads as follows:

> marking a first carrier for transporting the first container with the same machine readable code as said first container, and placing the container thereon;

This element would only be vitiated if the first carrier were not required to be marked at all, or perhaps arguably if the marking of the carrier could be uncorrelated to the marking on the specimen container. That is not the equivalents issue that would confront the Court if "same" machine readable code were construed to mean identical. The issue, as discussed above, would be whether providing the specimen container with correlated, non-identical machine readable codes is substantially similar to providing those items with codes that are identical. That inquiry would not eliminate the "code" limitation in its entirety. For a finding of infringement, it would still be necessary to find that the machine readable codes for the container and carrier are correlated. Thus, the question becomes whether a claim element is satisfied on the accused product, and so the "all elements" rule could not apply. Primos, 451 F.3d at 1850 ("because Primos's theory of equivalence (i.e., that a dome is equivalent to the claimed 'plate') does not 'effectively eliminate … [the 'plate' limitation] in its entirety,' it does not violate the all limitations rule.")

Siemens' argument is erroneous in that it effectively requires one-to-one literal correspondence with every word in the claim. Under Siemens' approach, no equivalents could ever exist for the claim element at issue. "Such an interpretation of the 'all elements' rule would swallow the doctrine of equivalents entirely" and is therefore legally improper. DePuy, 469 F.3d at 1018.

V. CONCLUSION

As a matter of claim construction, the claims of the '670 patent must be read in light of the patent's specification and the prosecution history. Read in that light, the claims of the '670 patent make clear that the "same machine readable code" used to mark a carrier means a code that is correlated with the machine readable code that marks the specimen container. Even if the Court were to construe this claim element as Siemens contends, there will remain issues of fact as to whether StreamLAB infringes the '670 patent literally or under the doctrine of equivalents.

For these reasons, and the other reasons set forth above, the University respectfully requests that the Court deny Siemens' Motion for Partial Summary Judgment.

Dated this 6th day of July 2010

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CERTIFICATE OF SERVICE

I hereby certify that on July 6, 2010, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will send notification of such filing to the following:

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s/ Andre R. Barry
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